

appear in Figure 3:

Satoh et al shows an assembly comprising a tube with a chamber with first and second end caps 46 that are secured to fixed structure 50. Satoh et al. show an air passageway 52 that extends through shaft 5, pneumatic roller 3 that is rotatably mounted on shaft means and shows shaft 5 being nonrotatable (col 7 lines 7+. Satoh et al disclose a pair of bearing means 6 (one shown). Satoh et al show transverse cut means as claimed as shown in figure 2 as well as the cuts being axially spaced. Satoh et al do not show the resilient material as claimed as well as a nip as claimed.

[Emphasis added.] The Examiner then asserted "[I]t would have been obvious to provide Satoh et al with nip means and resilient means as taught by Rock et al to provide deformation of the pressing force across the workpiece."

Thus, the Examiner clearly proposed that the teaching of Rock be incorporated in the assembly shown in Figure 3 of Satoh, which constituted Satoh's invention, not prior art to Satoh's invention.

Now, in rebuttal to Applicant's argument that the Satoh assembly would be rendered non-functional for its intended purpose by inclusion of the nip and resilient means of Rock, the Examiner for the first time cites a system entirely different than the Satoh assembly, namely prior art "rollers that have been used to contact the workpiece", which are mentioned in the Background of the Invention section of the

Satoh patent. Thus, the Examiner is now relying upon entirely different prior art and has effectively made a new ground of rejection. The discussion in Satoh of a contact roller refers to Japanese Unexamined Patent Publication No. 10-202839 [see col. 1, lines 15-30]. Had the Examiner expressly cited that Japanese reference, then there could be no denying that a new ground of rejection had been made. By relying upon the discussion in Satoh of prior art contact rollers, the Examiner has in effect done the same thing, i.e., cited new prior art.

Since it is improper to make a rejection final when a new ground of rejection has been asserted, the Applicant requests that the finality of the latest rejection be withdrawn.

REMARKS

In rebuttal to Applicant's showing that there would be no motivation for combining the teachings of Satoh and Rock, the Examiner asserts:

The motivation to combine the references is set forth in Rock et al with the resilient cover to retain pneumatic pressure and permit deformation of the cover material for adjustability purposes.

[Action, page 3.] This assertion is wrong in two respects. First, the teaching of Satoh is contrary to the teaching of "retaining pneumatic pressure" of Rock. First, Satoh teaches

that the pressurized air must escape through the perforations, not be retained, in order to provide an air cushion for the printed paper. Second, the workpiece in the case of Satoh is a sheet of paper. Paper does not require that the cover of a roller "permit deformation . . . for adjustability purposes." On the contrary, paper is uniformly flat and thin and never requires deformation of the roller cover in order to pass through a nip. Thus, there can be no motivation for incorporating the resilient cover of Rock in a roller nip for paper. Accordingly, a *prima facie* case for obviousness has still not been made.

Furthermore, the Applicant again respectfully submits that Satoh has been cited in error and is not combinable with the teaching of Rock, as set forth in detail in Applicant's response to the previous action. It would not be obvious to substitute a deformable pneumatic roller designed to contact the workpiece, as taught by Rock, for a pneumatic roller designed to not contact the workpiece, as taught by Satoh. To do so would render the Satoh system inoperative and frustrate the explicit purpose of the Satoh teaching. The Examiner's belated reliance on the mention of contact rollers in the Background section of Satoh is a tacit admission that the original rejection based on Satoh and Rock

is defective.

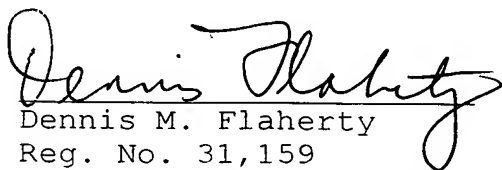
Finally, the Examiner's argument that Applicant's claim "does not recite the contact of a web but merely claims the structure of the roller assembly" is irrelevant to the issue of whether there would have been motivation to combine the teachings of Rock and Satoh.

If the Examiner intends to maintain the Final Rejection in an Advisory Action, the Applicant respectfully requests a telephone interview, with participation by the examiner's supervisor, Rinaldi Rada, before such Advisory Action is mailed.

In view of the foregoing, the Applicant submits that this application is now in condition for allowance. Reconsideration of the application and allowance of claims 1-11, 13-21 and 27-32 are hereby requested.

Respectfully submitted,

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Date


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September 13, 2005

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